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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,397	09/18/2001	Jaime A. Siegel	SNY-R4757	1207
24337	7590	09/06/2007		
MILLER PATENT SERVICES 2500 DOCKERY LANE RALEIGH, NC 27606			EXAMINER WINTER, JOHN M	
			ART UNIT	PAPER NUMBER
			3621	
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			09/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/955,397	<b>Applicant(s)</b> SIEGEL ET AL.	
	<b>Examiner</b> John M. Winter	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 38-43, 45, 46, 48-54, 56-62, 72-79, 84- 102 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-43, 45, 46, 48-54, 56-62, 72-79, 84- 102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

The Applicants arguments filed on June 12, 2007 have been fully considered. Claims 38-43,45,46,48-54, 56-62, 72-79, 84- 102 have been examined.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38, 46, 62 and 79 rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Claim 38 states "if the customer", this language is indefinite.

Claims 46, 62 and 79 are improper hybrid claims, claiming multiple statutory classes.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 38-43,45,46,48-54, 56-62, 72-79, 84- 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (US Patent 5,530,754 in view of Stefik (US Patent 5,715,403).

As per claim 38,

Garfinkle ('754) A method of delivering digital content, comprising:

receiving a request from a customer for transfer of A/V content in digital form to the customer; receiving payment from the customer for the transfer of the A/V content in accordance with a first usage rule; transferring audio/video content in digital form from a content provider to the customer in accordance with the first usage rule, the digital form of the A/V content comprising at least an audio portion and a video portion; (Column 3, lines 19-43; and Column 3 line 54 -- column 4 line 11; Figure 5)

wherein the selected portion comprises at least one of a soundtrack, a documentary segment, art interview, an audio segment, a video segment and a still image; wherein the customer is presented with the opportunity in a menu displayed at least just prior to, during or just tier presentation of the full selection of AV content; and enabling the customer to store the selected portion if the customer elects to complete the transaction. (Column 3, lines 19-43; and Column 3 line 54 -- column 4 line 11; Figure 5)

Garfinkle ('754) does not explicitly disclose providing limited usage rights to the AN content to tlae customer; presenting the customer with an opportunity to complete a transaction to acquire additional, rights to a selected portion of the A/V content. Stefik ('403) discloses providing limited usage rights to the AN content to tlae customer; presenting the customer with

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an opportunity to complete a transaction to acquire additional, rights to a selected portion of the A/V content (Figure 15). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Garfinkle ('754) method with the Stefik ('403) method since the combination of these elements does not alter their respective functions, the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Claims 46, 48, 62, 72, 79, 84 and 94 are in parallel with claim 38 and are rejected for at least the same reasons.

As per claim 39,

Garfinkle ('754) discloses the method according to claim 38,

Garfinkle ('754) discloses the claimed invention except for "second usage rule", It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a second IC card, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As per claim 40,

Garfinkle ('754) discloses the method according to claim 39,

wherein the transaction comprises one off a purchase of unlimited rights to play the selected portion, a purchase of rights to play the selected portion for a designated period of time, and a purchase of rights to play the selected portion a designated number of times. (Column 3,

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lines 19-43; and lines 54-63)

Claim 51 is in parallel with claim 40 and is rejected for at least the same reasons.

As per claim 41,

Garfinkle ('754) discloses the method according to claim 38,

wherein the A/V content further comprises a table of contents portion (TOC) that indexes the selected portion. (Column 3, lines 54-62)

Claims 52, 58 and 78 are in parallel with claim 41 and are rejected for at least the same reasons

As per claim 42,

Garfinkle ('754) discloses the method according to claim 38,

Garfinkle ('754) does not explicitly disclose the presenting and enabling take place within a designated period of time defined by the first usage rule. Stefik ('403) discloses the presenting and enabling take place within a designated period of time defined by the first usage rule (Figure 15). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Garfinkle ('754) method with the Stefik ('403) method since the combination of these elements does not alter their respective functions, the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention..

Claims 53, 77 and 102 are in parallel with claim 42 and are rejected for at least the same reasons

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As per claim 43,

Garfinkle ('754) discloses the method according to claim 38, wherein the A/V content comprises one of a motion picture, a television program, a documentary and a music video. (Abstract)

Claim 54 is in parallel with claim 49 and is rejected for at least the same reasons.

As per claim 45,

Garfinkle ('754) discloses the method according to claim 38, wherein the transferring comprises one of downloading the A/V content as one or more digital files, streaming the A/V content, and transmitting the A/V content as a real time transmission. (Abstract, Figure 5)

Claims 56, 75, 92 and 101 are in parallel with claim 45 and are rejected for at least the same reasons

As per claim 49,

Garfinkle ('754) discloses the method according to claim 48,

Official Notice is taken that "the storing comprises receiving a key code from the content provider to permit storing the selected portion" is common and well known in prior art in reference to content distribution. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a key or encryption code to enable the storing of content in order to only allow the media to be stored by authorized storage media

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Claims 87 and 96 are in parallel with claim 49 and are rejected for at least the same reasons

As per claim 50,

Garfinkle ('754) discloses the method according to claim 48,

wherein the storing comprises receiving a download from the content provider. (Abstract)

Claim 100 is in parallel with claim 50 and is rejected for at least the same reasons.

As per claim 57,

Garfinkle ('754) discloses the method according to claim 48, Garfinkle ('754) does not explicitly disclose the digital rights to the selected portion is associated with a usage rule that defines rights to limitations on a number of copies of the selected portion that can be made.

Stefik ('403) discloses the digital rights to the selected portion is associated with a usage rule that defines rights to limitations on a number of copies of the selected portion that can be made.

(Figure 15). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Garfinkle ('754) method with the Stefik ('403) method since the combination of these elements does not alter their respective functions, the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention..

Claims 89 and 98 are in parallel with claim 57 and are rejected for at least the same reasons.

As per claim 59

Garfinkle ('754) discloses the method according to claim 48,



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wherein the digital form of the A/V content is associated with a usage rule. (Column 3, lines 19-43; and lines 54-63)

Claim 76 is in parallel with claim 59 and is rejected for at least the same reasons.

As per claim 60

Garfinkle ('754) discloses the method according to claim 59,  
wherein the request to acquire digital rights to the selected portion is sent before the usage rule expires. (Column 3, lines 19-43; and lines 54-63)

As per claim 61

Garfinkle ('754) discloses the method according to claim 48,  
wherein the menu has a menu selection for acquiring digital rights to the selected portion.  
(Column 3, lines 19-43; and lines 54-63)

Claims 90 and 99 are in parallel with claim 61 and are rejected for at least the same reasons.

As per claim 73,

Garfinkle ('754) discloses the method according to claim 72,  
wherein the transaction comprises purchasing the selected portion of the AN content.  
(Column 3, line 66- Column 4, line 9)

As per claim 74,

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Garfinkle ('754) discloses the method according to claim 73,  
wherein the purchase secures usage rights to Store the selected portion distinct from the  
A/V content. (Column 4, lines 13-34)

As per claim 85,  
Garfinkle ('754) discloses the apparatus according to claim 84,  
wherein the A/V content is stored as one or more digital files. (Abstract)

Claims 91 and 95 are in parallel with claim 85 and are rejected for at least the same  
reasons.

As per claim 86  
Garfinkle ('754) discloses the apparatus according to claim 84,  
wherein the TOC is stored as one or more digital files. (Abstract)

As per claim 88  
Garfinkle ('754) discloses the apparatus according to claim 84,  
wherein the transaction comprises receiving a payment from the customer; and permitting  
the customer to store the selected portion in accordance with a usage role. (Column 3, line 66-  
Column 4, line 9), (Column 4, lines 13-34)

As per claim 93

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Garfinkle ('754) discloses the apparatus according to claim 84,

wherein fine transaction comprises one of: a purchase of unlimited rights to play the selected portion, a purchase of rights to play the selected portion for a designated period of time, and a purchase of rights to play the selected portion a designated number of times. (Column 3, line 66- Column 4, line 9)

As per claim 97

Garfinkle ('754) discloses the apparatus according to claim 94,

wherein the transaction comprises sending a payment; and storing the selected portion in accordance with a usage rule. (Column 3, line 66- Column 4, line 9), (Column 4, lines 13-34)

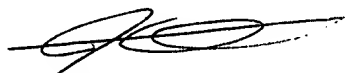
### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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